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EXAMINER

METZMAIER, DANIEL S

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/763,084

Applicant(s)

BARA, ISABELLE

Examiner

Daniel S. Metzmaier

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 27-88 is/are pending in the application.
- 4a) Of the above claim(s) 87 and 88 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 27-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7 6) ☐ Other: _____

DETAILED ACTION

Claims 1 and 26-88 are pending. Claims 1, 44-46, 50, 53, 56, 71, 73 and 77 have been amended in the amendment filed March 5, 2003, Paper No. 14.

Election/Restrictions

1. Claims 87-88 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 12.
2. This application contains claims 87-88 drawn to an invention nonelected with traverse in Paper No. 12. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Information Disclosure Statement

3. A copy of the IDS, Paper No. 7 is attached. Said copy reflects that reference number 4 has been considered. The examiner regrets any inconvenience.

Claim interpretation

4. Applicant's comments are noted. Attention is further directed to MPEP 2111.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 and 26-86 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language defining "protein derivatives" does not define "protein derivatives" "and derivatives thereof". Please see claim 27. It is unclear what is a derivative of a protein derivative.

Several of the claims contain improper alternative groupings that should be corrected. Attention is directed to MPEP 2173.05(h). An example may be found in claim 26 where the grouping does not use closed language and employs "and" several times. Said grouping is indefinite as to the scope of its members and the grouping. It is suggested applicants insert - - the group consisting of - - after chosen from and amend the groups to remove multiple use of "and".

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 84-86 are rejected under 35 U.S.C. 102(b) as being anticipated by Rutter et al., US 5,731,191. Rutter et al (column 13, Table III) discloses growth mediums that are gels comprising gellan gum and polyethylene glycol (PEG) having a molecular weight of 4000. A molecular weight of 4000 for PEG equates to about 90 units of

oxyethylene. Rutter et al (Table I) discloses the gels have salts and vitamins and aminoacids in the compositions.

The gellan gum is employed at 2 g/l, which equates to about 0.2 % by weight of the composition. The PEG is employed at 0-100 g/l, which equates to about 0-10% by weight of the composition.

The disclosure of activated carbon reads on applicants' broad claim to pigments and fillers.

While the claims have been examined to the extent said claims read on the elected species, many of the claims define species of the hydrophilic gelling agent other than gellan gum but are generic to and read on the gellan gum as an alternative species.

9. Claims 1, 26-27, 36-37, 39-40, 59, 62-64, 69-70, 73-75, 77-79 and 83-86 are rejected under 35 U.S.C. 102(b) as being anticipated by Bara et al., US 5,626,853. Bara et al (example 1) disclose gel blusher compositions reading on the claims. The organopolysiloxane is a fatty phase as claimed. See instant claim 70 limiting water soluble dyes employed in the Bara et al compositions.

While the claims have been examined to the extent said claims read on the elected species, many of the claims define species of the hydrophilic gelling agent other than gellan gum but are generic to and read on the gellan gum as an alternative species. Examples of this is claim 27. Claims drafted in this manner are rejected over the instant reference as anticipated since they read on the use of gellan gum.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12.

13. Claims 1 and 26-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Intecos Italia SpA, EP 0 803 245 A, in view of Ha et al, US 5,997,887, Bara et al., US 5,626,853, and Roulier et al, WO 97/17055, as evidenced by patent family member US 6,045,814.

Intecos Italia SpA (examples) discloses solid gels employing a polysaccharide gelling agent and polyethylene glycol 200 and 400. Intecos Italia SpA (column 1, line 37 discloses as polysaccharides, the use of gellan.

Intercos Italia SpA differs from the claims in the molecular weight to the PEG (examples and column 1, lines 40-44).

Ha et al (column 29, lines 8-11) teaches a range of PEG-2, PEG-3, PEG-30 and PEG-50 as conditioning materials.

These references are combinable because they teach cosmetic compositions. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ the PEG compound of varied molecular weight as obvious functional equivalents shown to be conventional in the cosmetic art.

Bara et al (column 3, line 64 to column 4, line 7 and examples, particularly example 1) discloses the use of polyethylene glycol 600 (PEG-12) in combination with other gelling agents in forming solid gels. Bara et al (claim 12, line 4) further teaches the use of gellan as a gelling agent in said solid gels as well as polyethylene glycols (claim 12, line 7).

These references are combinable because they teach solid gel cosmetic compositions. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ the gellan / PEG-12 combination as obvious functional equivalents shown to be conventional in the cosmetic art as evidence by the Bara et al reference.

To the extent the claims further differ from the Intercos Italia SpA and Bara et al references in the incorporation of further ingredients, Roulier et al discloses conventional additives to solid cosmetic compositions including the use of numerous overlapping hydrophilic gelling agents.

These references are combinable because they teach solid gel cosmetic compositions. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to employ fillers, pigments and nacreous substances as obvious conventional additives in making solid gel cosmetic compositions as shown to be conventional in the Roulier et al reference.

Many of the claims may be rejected as reading on the genus when limitations to a single species are set forth in the alternative to the remaining species of the genus.

14. Bara et al, US 5,637,291, is considered cumulative to Roulier et al for at least some of the claims further including fillers. Attention is specifically directed to column 9, lines 15-36, which discloses compositions closely resembling those of Bara et al, US 5,626,291, example 1.

Response to Arguments

15. Applicant's arguments with respect to claims 1 and 26-86 have been considered but are moot in view of the new ground(s) of rejection.

16. Applicant's arguments filed March 5, 2003 have been fully considered but they are not persuasive.

17. Applicant (pages 5 and 6) asserts the examiner has provided no legal basis for the conclusion that the claims do not provide proper alternative language. The rejection states that "chosen from" is deemed to be open language. The use of open language defining alternative groups is specifically prohibited in MPEP 2173.05(h).

18. Applicant (pages 5 to 6) assert the term derivatives has been defined in the specification and one having ordinary skill in the art would understand the scope of said

terms. The language defining "protein derivatives" does not define "protein derivatives" "and derivatives thereof". Please see claim 32.

19. Regarding Rutter et al, amendments have not been made in claims 84-86 as in claim 1.

20. Applicants (pages 7-9) assert the examiner has employed an obvious to try standard. This has not been deemed persuasive since the solid gels are taught in the art and the formation would have been within the level of one having ordinary skill in the art at the time of the invention as shown in the prior art references. Attention is further directed to applicants claimed invention at claim 1, 84-86 wherein the formation of a gel broadly combines an aqueous dispersion of a hydrophilic gelling agent and polyethylene glycol (12-180) to form a solid gel. Said formation is shown in the art. The combination of references merely teaches the various components that may be substituted as conventional additives in the solid gel cosmetic art. A prima facie case of obviousness having been presented, applicants have presented no evidence or probative arguments that the claimed compositions are unexpected or unobvious over the prior art.

21. Applicants (pages 9 and 10) assert the Bare et al reference teaches away from the instant invention by the use of synthetic acrylate gelling agents. Applicants have presented no evidence that the gallant gelling agents have unobvious properties over the aculeate gelling agents exemplified in the Bare et al reference. Furthermore, the claims are generic to the acrylate gelling agents, which are hydrophilic gelling agents.

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (703) 308-0451. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on (703) 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Daniel S. Metzmaier
Primary Examiner
Art Unit 1712

DSM
May 19, 2003